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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/763,704      | 02/26/2001  | Matthias Witschel    | 49365               | 9140             |

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| EXAMINER |
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ROBINSON, BINTA M

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| ART UNIT | PAPER NUMBER |
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1625

DATE MAILED: 06/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/763,704

Applicant(s)

WITSCHER ET AL.

Examiner

Binta M. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other:  |

**Detailed Action**

The restriction requirement made at paper no. 10 is made final. The 112, second paragraph rejection of claim 23, is withdrawn in light of applicant's remarks at paper no. 14. The 112, first paragraph rejection of claims 13 and 25 are withdrawn in light of applicant's amendment at paper no. 14.

**(modified rejections)**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim(s) 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 22 in part is indefinite for being improper product use claims. Applicant is referred to *Clinical Products v. Brenner* -Commissioner of Patents) 149 USPQ 475 (District Court DC 66) Ex parte Dunki 153 USPQ 678 (Bd of Appeals 1967).

**(old rejections)**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 and 14-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, does not provide enablement for 3 cyanos, nitros or other electron withdrawing groups on R1 equal t o phenoxy in the ortho position, R1 equal to all heterocyclyloxy, or heterocyclylthio, R5 equaling N-linked heterocyclyl or O-(N-linked heterocyclyl), it being possible for the heterocyclyl radical

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of the two last-mentioned substituents to be partially or fully halogenated and/or to carry one to three of the following radicals: nitro, cyano, C1-C4-alkyl, C1-C4-haloalkyl, C1-C4-alkoxy or C1-C4-haloalkoxy, R7 equaling heterocyclyl, heterocyclyl-C1-C6-alkyl, heterocyclylcarbonyl-C1-C6-alkyl, heterocyclylcarbonyl, heterocyclylaminocarbonyl, N-(C1-6-alkyl)-N-(heterocyclyl)aminocarbonyl, heterocyclyl-C2-C6-alkenylcarbonyl, it being possible for these radicals to be partially or fully halogenated and/or to carry one to three of the substituents claimed, R8 and R9 equally to all heterocyclyl, heterocyclyl-C1-C6-alkyl, heterocyclyloxy, it being possible for these radicals to be substituted as claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The claims as recited are broader than the scope of enablement. The specification lacks direction or guidance for placing all of the alleged products in the possession of the public without inviting more than routine experimentation. The applicant is referred to *In re Wands*, 858 f.2d 731, 737, 8'USPQ2d 1400, 1404 (Fed. Cir. 1988) which includes the incorporation of the 8 factors recited in Ex parte Foreman 230 USPQ 546 (Bd. Of App. And Inter 1986).

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue". These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art 6) the amount of direction provided by the inventor 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In *re Wands*, 858 F. 2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

In terms of the first Wands factor of breadth, R1, R5, R7, R8, and R9 encompass a much wider Markush grouping of radicals than those radicals tested and synthesized. The nature of the invention is that these compounds are useful for controlling undesirable plants as described. In terms of the fifth Wands factor, the level of predictability in the art is low since none of the actual data values for activity against harmful plants was disclosed in the specification. In terms of the sixth Wands factor, the amount of direction provided by the inventor is poor, because the applicant does not disclose actual data values for activity against harmful plants was disclosed in the specification. Additionally, the applicant does not test the whole breadth of compounds encompassing all of the moieties that these particular radicals can be.

In terms of the 8<sup>th</sup> Wands factors, undue experimentation would be required to make or use the invention based on the content of the disclosure due to the breadth of the claims, the level of predictability in the art of the invention, and the poor amount of direction provided by the inventor. Taking the above factors into consideration, it is not seen where the instant claim is enabled by the instant application.

#### **Response to Applicant's Remarks**

##### **112, second paragraph rejection of claims 22**

The applicant traverses the 112, second paragraph rejection of claim 22, asserting that it is not in an improper use format, since it is drawn to a composition made up of a compound of formula I. However, the claim also refers to a use without any active, positive steps delimiting how this use is actually practiced. In *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967), the Board held the following claim to be an improper definition of a process: "The use of a high carbon austenitic iron alloy having a proportion of free carbon as a vehicle brake part subject to stress by sliding friction." In the instant case, the phrase "used for formulating crop protection agents" would also be held an improper definition of a process under *Dunki*.

**112, first paragraph rejection of claims 1-25**

The applicants traverse the 112, first enablement rejection of 2 to 3 electron withdrawing groups on R1 equal to phenoxy pointing to two examples of such compounds, examples 2.11 and 2. 46. However, the applicant does not disclose R1 equal to phenoxy being able to be substituted with three electron-withdrawing groups.

The applicant also traverses the enablement rejection of R1 equal to all heterocycloxy, or heterocycylthio, R5 equaling N-linked heterocyclyl or O-(N linked heterocyclyl), alleging that as the level of knowledge publicly held by those of skill in the art increases, the amount of disclosure necessary to meet the enablement requirement decreases. However, any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement is whether the experimentation needed to practice the invention undue or unreasonable. That standard is still the one to be applied. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). The question of what constitutes undue experimentation was considered by the Federal Circuit in **In re Wands** [49] where the Court noted a prior decision of the PTO Board of Appeals [50], which had listed factors to be considered, and then applied them to the case before it. The factors to be considered were:

- (1) the quantity of experimentation necessary;
- (2) the amount of direction or guidance provided;
- (3) the presence or absence of working examples;

- (4) the nature of the invention;
- (5) the state of the prior art;
- (6) the relative skill of those in the art;
- (7) the predictability or unpredictability of the art; and
- (8) the breadth of the claims.

To be enabling, the specification of the patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. In terms of the fifth Wands factor, the level of predictability in the art is low since none of the actual data values for activity against harmful plants was disclosed in the specification. In terms of the sixth Wands factor, the amount of direction provided by the inventor is poor, because the applicant does not disclose actual data values for activity against harmful plants was disclosed in the specification. Additionally, the applicant does not test the whole breadth of compounds encompassing all of the moieties that these particular radicals can be. There is no reasonable correlation between the narrow disclosure in applicant's and the broad scope of protection sought in the claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.

Binta Robinson

  
May 28, 2003



ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
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